

NETFLIX, INC. v. BLOCKBUSTER INC.

Case No. 06 2361 WHA (JCS)

EXHIBIT A

TO

**DECLARATION OF WILLIAM J. O'BRIEN IN SUPPORT OF
BLOCKBUSTER'S BRIEF ON CLAIM CONSTRUCTION**

Filed on December 27, 2006

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1 IN THE SUPREME COURT OF THE UNITED STATES

2 - - - - - x

3 KSR INTERNATIONAL CO., :

4 Petitioner :

5 v. : No. 04-1350

6 TELEFLEX, INC., ET AL. :

7 - - - - - x

8 Washington, D.C.

9 Tuesday, November 28, 2006

10

11 The above-entitled matter came on for oral

12 argument before the Supreme Court of the United States

13 at 11:04 a.m.

14 APPEARANCES:

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16 Petitioner.

17 THOMAS G. HUNGAR, ESQ., Deputy Solicitor General,

18 Department of Justice, Washington, D.C.; on

19 behalf of the United States, as amicus curiae,

20 supporting Petitioner.

21 THOMAS C. GOLDSTEIN, ESQ., Washington, D.C., on behalf

22 Of Respondents

23

24

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1 P R O C E E D I N G S

2 (11:04 a.m.)

3 CHIEF JUSTICE ROBERTS: We'll hear argument
4 next in No. 04-1350, KSR International versus Teleflex,
5 Incorporated.

6 Mr. Dabney.

7 ORAL ARGUMENT OF JAMES W. DABNEY

8 ON BEHALF OF THE PETITIONER

9 MR. DABNEY: Mr. Chief Justice, and may it
10 please the Court:

11 This case concerns a very broadly worded
12 patent claim, claim 4 of the Engelgau patent, that the
13 Solicitor General and the United States Patent and
14 Trademark Office have both told this Court is invalid
15 under Section 103 of the Patent Act and was issued in
16 error. The Federal Circuit's vacatur of summary
17 judgment in this case is grounded in a judicially
18 devised test that is fundamentally inconsistent with --

19 JUSTICE GINSBURG: May I ask, if that's the
20 position of the PTO, why aren't they proceeding to
21 cancel the patent?

22 MR. DABNEY: The case is in litigation at
23 this point, Justice Ginsburg, and in patent litigation
24 district courts are vested with authority and this
25 Court is vested with authority to render a judgment of

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1 invalidity under Section 282 of the Patent Act.

2 JUSTICE GINSBURG: But the question is, you
3 say the PTO has recognized that it issued this patent,
4 that it's an invalid issuance. So why aren't they
5 curing their own mistakes, never mind what a court is
6 going to do?

7 MR. DABNEY: Well, there is the possibility
8 of director- initiated re-examination of patents as
9 certainly an administrative remedy that does exist. But
10 where a case is in pending litigation such as this, the
11 traditional way that these disputes are resolved is for
12 a court to apply the law to the facts and render a
13 judgment on a defense of invalidity which has been
14 pleaded to the plaintiff's claim of patent infringement
15 in this case. This issue arises in the context of a
16 defense pleaded to a claim for patent infringement and
17 I'm not sure that the Patent Office really could swoop
18 in and cut off the plaintiff's claim in the manner Your
19 Honor is suggesting.

20 The Federal Circuit in this case applied the
21 approach it's applied in previous cases, which is a
22 categorical approach. The Federal Circuit says that no
23 matter what might be the nature of an alleged invention
24 or improvement, no matter how broad might be a claim
25 made in an issued patent, no matter how small might be

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1 the difference between a patent claim and prior art, and
2 no matter how modest might have been the degree of skill
3 needed to devise subject matter described by a patent
4 claim, the Federal Circuit says regardless of any or all
5 of that a court of the United States can never, ever
6 sustain a defense of invalidity under Section 103 of the
7 Patent Act except in a very limited and narrowly defined
8 circumstance.

9 That circumstance is a record that includes
10 clear and convincing evidence, that yields a jury
11 verdict or specific finding showing what the Federal
12 Circuit calls a teaching, suggestion, or motivation to
13 combine prior art teachings in the particular manner
14 claimed by the patent at issue. The decision in this
15 case treats Section 103 not, as this Court has said, as
16 a codification of a condition for patentability whose
17 benchmark is skill and ingenuity. The decision in this
18 case treats section 1 as implementing a supposed
19 entitlement to patent protection that a court --

20 JUSTICE GINSBURG: You're talking about in
21 this case.

22 MR. DABNEY: Yes.

23 JUSTICE GINSBURG: We're talking about what
24 the law should be. Would you make, be making the same
25 argument if we were looking at the most recent decisions

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1 of the Federal Circuit, the ones that they issued within
2 the year, and each as I remember they held that the
3 patent was obvious and therefore invalid? Suppose we
4 were dealing in what was, the cases were, what were
5 they, Kahn, Alpha, and Diestar?

6 MR. DABNEY: Your Honor, what the Federal
7 Circuit has done in recent times has been after a
8 certiorari was granted in this case to erect a series of
9 escape devices from what is otherwise a categorical test
10 that must be imposed in all cases. As a practical
11 matter the Federal Circuit still characterizes as an
12 issue of fact for determination by a jury the presence
13 or absence of teaching, suggestion, or motivation, and
14 so these seemingly remedial steps that have been taken
15 by the Federal Circuit do not materially affect the
16 problem that's praised by this case, which is the well
17 nigh impossibility nowadays of being able to have an
18 efficient, inexpensive, quick and predictable
19 determination of whether claimed subject matter meets
20 the statutory standard.

21 JUSTICE ALITO: But what is the difference
22 between asking whether something is implicit in the, in
23 the prior art and simply asking whether it would have
24 been obvious to a person of ordinary skill in the art?

25 MR. DABNEY: The statute and this Court's

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1 precedents make the benchmark of patentability skill,
2 what degree of skill is needed to devise subject matter
3 in respect to an objectively defined problem, objective
4 looking at the claim and looking at the prior art? What
5 the Federal Circuit is talking about now is an inquiry
6 into motivation, not skill. Those two are very
7 different concepts. There is not a word in this Court's
8 precedents that says that whether a patent should be
9 granted or not depends on whether a hypothetical person
10 had hypothetical motivation to do what everybody knows
11 he could do.

12 CHIEF JUSTICE ROBERTS: Of course, the
13 reason that the Federal Circuit has devised this
14 additional test or gloss on Graham is that they say
15 obviousness is, it's deceptive in hindsight. In
16 hindsight everybody says, I could have thought of that;
17 and that you need -- if you don't have the sort of
18 constraint that their test imposes, it's going to be too
19 easy to say that everything was obvious.

20 MR. DABNEY: Well, the Court, Mr. Chief
21 Justice, the Court needs to be very clear what is meant
22 by the term "hindsight." If by hindsight is meant
23 looking at what's claimed now, the subject matter sought
24 to be patented, and comparing that to the prior art, to
25 call that analytical process improper hindsight is to

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1 make a frontal assault on the statute itself. If by
2 hindsight means to posit a desired result, a clay
3 doorknob, and to ask whether more skill and ingenuity
4 than were required by ordinary skill in the art was
5 needed to do that, to say that that constitutes improper
6 hindsight is to make a frontal assault on the entire
7 body of this Court's precedents construing section 103
8 and its common law predecessors.

9 With regard to the kind of bias Your Honor
10 is talking about, this Court's precedents provide a
11 wealth of mechanisms for protecting against that,
12 including the statement towards the end of the Graham
13 opinion, which is the only source of the word
14 "hindsight" that I've seen cited in the amici brief,
15 which was a discussion of the secondary consideration.
16 So that in a case like Goodyear against Rayovac there's
17 an excellent case where the claimed subject matter seems
18 so simple in hindsight. This was a case decided by this
19 Court in 1944. A leakproof battery that had been a
20 problem that had defied solution for years and there was
21 all kinds of motivation to solve it, and the fact that
22 it was not solved was considered important by this Court
23 in sustaining the validity of the patent in that case,
24 which claimed nothing more than a sheet metal sheath
25 wrapped around the electrodes and materials generated in

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1 the battery.

2 JUSTICE BREYER: I can understand, I think,
3 what a teaching is. I take it a teaching is you put all
4 the prior art -- that's what I guess that's what Judge
5 Rich explained, which I thought was very enlightening to
6 me in I can't remember the name of the case, Wigmore,
7 Winsmore --

8 MR. DABNEY: Winslow.

9 JUSTICE BREYER: Winslow. You put it all
10 around the room. All right, we've got it all around the
11 room, and I begin to look at it and if I see over that
12 it somehow teaches me to combine these two things, if it
13 says, Breyer, combine this and that, that's a teaching
14 and then it's obvious. Now, maybe it doesn't have the
15 teaching, it just has the suggestion. Maybe it says, we
16 suggest you combine this or that; okay, then it's
17 obvious. But I don't understand, though I've read it
18 about 15 or 20 times now, it though I've read it about
19 15 or 20 times now, I just don't understand what is
20 meant by the term "motivation."

21 MR. DABNEY: Well, the best I think anybody
22 could do would be to look at the opinion in this case
23 and try to figure that out.

24 JUSTICE BREYER: I tried. You've read a lot
25 of cases. You're a patent lawyer, and so what is the

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1 understanding as best you have it of what is just meant
2 by the term "motivation"? To be more specific, if they
3 mean motivated to go look to the prior art, well,
4 anybody would want to look in the prior art. If I want
5 to invent something I'll look anywhere. I'll look to
6 the prior art. I'll look to the Library of Congress.
7 I'll look to my cousin. I mean, I'll look wherever I
8 can find it. So they can't mean that, and if they don't
9 mean that what do they mean?

10 MR. DABNEY: Well, in this case what the
11 respondents is Mr. Engelgau would have had no motivation
12 to look to the Asano-designed pedal because he was
13 trying to meet the requirements of Fort Motor Company
14 and Asano would not have met those requirements and
15 therefore Mr. Engelgau would have had no motivation to
16 start with Asano.

17 JUSTICE BREYER: Say that again? You
18 wouldn't have a motivation to look to the prior art to
19 find your problem. What's an example where you have a
20 motivation distinguishing you from everybody else? I
21 mean, everybody has a motivation to look to the prior
22 art.

23 JUSTICE GINSBURG: You disagree with the
24 motivation test.

25 MR. DABNEY: Yes.

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1 JUSTICE GINSBURG: So perhaps you're not the
2 --

3 JUSTICE BREYER: Right person to ask.
4 (Laughter.)

5 MR. DABNEY: I respectfully suggest --

6 CHIEF JUSTICE ROBERTS: You don't have a
7 motive to answer that question right away.

8 JUSTICE BREYER: Fine, that's fine.

9 MR. DABNEY: I believe if you study
10 carefully this Court's precedence, including Graham
11 itself and just about every other case this Court has
12 ever decided, what this Court has said is the measure,
13 what our society agreed to pay off on is subject matter
14 that reflects a certain degree of skill. And this Court
15 has rejected time and time again the notion that someone
16 who was the first simply to take advantage of the known
17 capability of technology was entitled to a patent.

18 JUSTICE KENNEDY: Well, would it be, would
19 it be inadvisable for us to say the motive test teaches
20 us something important; it has a valuable place; it's
21 just not the exclusive test for what's obvious.

22 MR. DABNEY: Certainly.

23 JUSTICE KENNEDY: Or do we have to reject it
24 all out of -- out of hand?

25 MR. DABNEY: The -- the presence or absence

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1 of motivation to devise something.

2 JUSTICE KENNEDY: Motivation in this special
3 sense.

4 MR. DABNEY: Well, I'm not sure it is in a
5 special sense. What the Federal Circuit has done is
6 has, it has attributed controlling significance to what
7 is in most cases at best a factor, and in fact is
8 nothing more than a legal argument about the preemptive
9 effect of prior art. The motivation debate in this case
10 is all about what is the preemptive legal effect of the
11 Asano reference. It either invalidates the claim --

12 JUSTICE KENNEDY: But, but, but my question
13 is does it not serve to show us at least one way in
14 which there can be obviousness?

15 MR. DABNEY: I would agree that if there is
16 --

17 JUSTICE KENNEDY: It may not be the
18 exclusive test. We're -- I'm asking what the test ought
19 to be.

20 MR. DABNEY: Well, the test, I mean in this
21 case, the specific claim at issue in this case is very
22 analogous to the claim that this Court considered in the
23 Anderson's-Black Rock case. What we have in this case
24 is no dispute as to any of the factual inquiries that
25 have traditionally defined patent validity analysis.

1 The prior art that we rely on, it's undisputed that it's
2 prior art and it's in the record. The level of skill is
3 undisputed. The quantum of difference between the
4 claimed subject matter and the prior art is undisputed.
5 The only issue in this case is what legal consequences
6 follow from that. What question do you ask to decide
7 whether or not that difference adds up to a patentable
8 invention?

9 It's very analogous to what was going on in
10 the Anderson's-Black Rock case. Anderson's-Black Rock
11 was a case like this in which someone had invented a
12 radiant heat burner and the patentee in that case had
13 seen that there was a market for using that by attaching
14 it to an asphalt spreader. So the patent claim in that
15 case was taking someone else's invention, the radiant
16 heat burner and hanging it on a standard painting
17 apparatus and using it for its, one of its marketable
18 purposes.

19 This Court held in this, in the
20 Anderson's-Black Rock case that the patentee had not
21 done anything patentable in that case. All he had done
22 was take a burner that functioned as a burner, and a
23 spreader that functioned as a spreader, and the two
24 components did not affect one another's operation at
25 all. It was in the parlance of this Court's precedents,

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1 an aggregation.

2 JUSTICE SCALIA: How does -- how does
3 motivation enter into that analysis in that case? How
4 would you, how would you have applied the motivation? I
5 -- like Justice Breyer, I don't understand what the
6 motivation -- motivation element is. How would you have
7 applied the --

8 MR. DABNEY: Well, if the patentee in that
9 case --

10 JUSTICE SCALIA: He had no particular
11 motivation to use that earlier patent, did he?

12 MR. DABNEY: Well, actually in that case
13 there actually was quite a story. In that case there
14 was a story that for years and years you'd had this cold
15 joint problem of laying successive courses of asphalt
16 blacktop, and -- and this guy actually saw something
17 that was interesting, that you could use this radiant
18 heat burner to solve the asphalt blacktop problem. That
19 was not what he claimed, though.

20 What he claimed was an apparatus that just
21 had these two things together, and they didn't interact
22 with one another any more than if they had been both put
23 in the same shopping bag. And that's what we have in
24 this case. We have an adjustable pedal assembly that
25 does whatever --

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1 JUSTICE KENNEDY: No. No. No. It took
2 from 10 years to go from -- I think 10 years from Asano
3 to Engelgau, so it must have been not all that obvious.

4 MR. DABNEY: Well, the, on this record, and
5 even if you take at face value what's said in the
6 respondent's brief in this case, which is very largely
7 not based on the record, the story is, from Mr. Engelgau
8 is, Fort Motor Company had a particular requirement and
9 Mr. Engelgau sat down to design to it. He to design a
10 pedal that had would meet Ford's requirements and one
11 way that he did that was to come up with the kind of
12 pedal assembly that's shown in the figures of the
13 patent.

14 But we are not here talking about the
15 patentability of the figures of the patent. We are not
16 talking about the patentability of claims 1, 2 or 3 of
17 the patent; we are talking about claim 4 in which these
18 respondents got a little greedy. Claim 4 describes
19 almost nothing --

20 JUSTICE KENNEDY: Do you, do you concede --
21 do you concede that claims 1 through 3 are valid?

22 MR. DABNEY: We take no position on that.
23 They're not an issue in the case.

24 JUSTICE KENNEDY: If I had asked your
25 opinion as an expert would you --

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1 (Laughter.)

2 MR. DABNEY: Well, Your Honor, with respect,
3 I would have no opinion on that question.

4 (Laughter.)

5 MR. DABNEY: I could stand here and make
6 arguments.

7 JUSTICE KENNEDY: Well, I mean it seems to
8 me that the whole argument that you're making as to Ford
9 is that anybody knows you could, you use an electronic
10 -- you have an electronic throttle, it serves a purpose;
11 the pedal serves a purpose; put the two together.

12 MR. DABNEY: Here's the --

13 JUSTICE KENNEDY: Why doesn't -- don't 1, 2
14 and 3 do the same thing?

15 MR. DABNEY: Well, because -- because --

16 JUSTICE KENNEDY: If they're invalid then I
17 have -- then I'm struggling to find what your test is.

18 MR. DABNEY: Here's the reason.

19 JUSTICE KENNEDY: I don't know what your
20 test is.

21 MR. DABNEY: Here's the reason. What's
22 shown in the figures of the Engelgau patent is an
23 adjustable pedal assembly that has a large bore tube
24 from which you suspended a pedal arm on a yoke, and it
25 slides back and forth along the tube. And that's the

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1 way that it provides for adjustment. And in claims 1, 2
2 and 3 some of that structure is recited. So those
3 claims would not necessarily be invalid by the Asano
4 reference because the Asana adjustment mechanism doesn't
5 use a tube, and doesn't use a yoke; it uses pins and
6 slots and it provides adjustment by a different
7 mechanism. The respondents have not asserted claims 1,
8 2 and 3 in this case because those claims don't describe
9 anything remotely like the petitioner's pedals. They
10 limited their claim to claim 4 because only by claiming
11 this enormous verbal abstraction that is claim 4 can
12 they make a colorable claim of patent infringement
13 against the petitioner in this case.

14 So I would respectfully submit that the
15 Court does not need to decide whether 1, 2 or 3 would be
16 valid but the point would be, the question would be what
17 we did in the Hotchkiss case or in the Anderson's-Black
18 Rock case or any of these cases. Would it have required
19 more than ordinary skill to devise that claim structure
20 with those additional structural limitations to solve
21 some objectively defined problem, and that hasn't been
22 litigated or briefed.

23 JUSTICE KENNEDY: Going back to the asphalt
24 case, were you suggesting that if they had made a claim
25 for a process patent, that it might have been valid?

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1 MR. DABNEY: Conceivably. If there are no
2 further questions I'd like to reserve the rest of my
3 time.

4 CHIEF JUSTICE ROBERTS: Thank you,
5 Mr. Dabney.

6 Mr. Hungar.

7 ORAL ARGUMENT OF THOMAS G. HUNGAR

8 ON BEHALF OF THE UNITED STATES, AS AMICUS CURIAE

9 SUPPORTING PETITIONER

10 MR. HUNGAR: Thank you, Mr. Chief Justice,
11 and may it please the Court.

12 Construed as the sole means of proving
13 obviousness the teaching suggestion motivation test is
14 contrary to the Patent Act, irreconcilable with this
15 Court's precedents and bad policy. It asks the wrong
16 question and in cases like this one, it produces the
17 wrong answer. It should be rejected and the judgment of
18 the Court of Appeals should be reversed.

19 CHIEF JUSTICE ROBERTS: What do you
20 understand motivation to refer to in that test?

21 MR. HUNGAR: Well, it's not entirely clear,
22 Your Honor. I think that it's sometimes difficult to
23 distinguish, certainly between motivation and
24 suggestion. One way in which it is used for example, is
25 if there were some indication in the prior art that

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1 doing something a certain way might save money and then
2 there would be a motivation to save money, which might
3 supply the requisite motivation for combining the two
4 prior art references.

5 JUSTICE KENNEDY: Do you agree that in that
6 context it would serve a valid purpose, i.e., can we --
7 that is to say, can we keep the motivation test and then
8 supplement it with other, with other means of, other
9 ways of showing obviousness?

10 MR. HUNGAR: Yes, Your Honor. We agree that
11 teaching suggestion and motivation are valid means of
12 proving obviousness, valid considerations for the Court.
13 And this Court's precedents are entirely consistent with
14 that. A number of cases cited by respondent show that
15 the Court has looked to suggestion as a means to
16 determining whether a patent is obvious.

17 The problem with the Federal Circuit's test
18 is it makes that the exclusive test and precludes
19 obviousness determinations in the absence of
20 satisfaction of that test which this Court's precedents
21 are clearly not consistent with. In fact in Graham
22 itself, in the Sakraida case, in Dann against Johnston,
23 lower courts had held patents valid because of a lack of
24 suggestion. This Court reversed without requiring or
25 even addressing the question whether there was some

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1 explicit principle that had been proven by the party
2 challenging the patent, by clear evidence that there was
3 such a teaching suggestion motivation. It's just
4 foreign to this Court's precedents as a mandatory
5 prerequisite for obviousness.

6 JUSTICE SOUTER: What do you make of the,
7 sort of the revolution argument that whether it's
8 contrary or intention with, in fact the, it's been
9 applied in what is now the Fed Circuit for what, 20
10 years, more than 20 years I guess. And to tip it over
11 now is going to produce chaos. What's the answer to
12 that?

13 MR. HUNGAR: Well, several things, Your
14 Honor. First of all, of course, there can be no
15 legitimate reliance in lower court precedent that's
16 contrary to Supreme Court precedent, and it was an open
17 secret in the patent bar that the approach being taken
18 by the Federal Circuit was inconsistent with cases such
19 as this Court's Sakraida decision.

20 JUSTICE SOUTER: Well, I realize there's
21 been comment on it, but guess I'm -- I'm raising the
22 question that comes up in the old motto. I mean, if the
23 error is common enough and long enough, the error
24 becomes the law. And in effect is that what we are
25 confronted with here?

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1 MR. HUNGAR: No, Your Honor. I just think
2 it would be dangerous proposition for this Court to
3 endorse that line of argumentation but even leaving that
4 aside, it's not justified here on the facts. And this
5 patent is a good example. No one is suggesting that
6 claims 1 through 3 are invalid; the problem here is that
7 claim 4 sweeps so broadly, so much broader than what the
8 applicant in fact invented, that it sweeps in obvious
9 manifestations.

10 JUSTICE SOUTER: No, but -- if we see it
11 your way, are there going to be 100,000 cases filed
12 tomorrow morning?

13 MR. HUNGAR: I don't think so, Your Honor.
14 What we are talking about here are claims at the outer
15 boundaries of patentability, even under the Federal
16 Circuit's test. And in those cases there will no doubt
17 be some claims, such as the claim in this case that can
18 be resolved at summary judgment by a court, that the
19 court can simply determine as a matter of law, it's
20 obvious. Whereas under the Federal Circuit's test it
21 has to go to a jury and the somewhat unpredictable, at
22 the least --

23 JUSTICE GINSBURG: Mr. Hungar, this is the
24 problem that I have with your test. I think I
25 understand you right, now, just to say teaching

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1 suggestion motivation has its place; it's okay; but it
2 shouldn't be the exclusive test.

3 MR. HUNGAR: Correct.

4 JUSTICE GINSBURG: And what I understand
5 your brief to say is that it has to be supplemented with
6 what you have called, you've labelled "sufficiently
7 innovative." And then I begin to think well, what's
8 "sufficiently innovative?" How is a trier supposed to
9 know if something -- in other words I think what you're
10 suggesting as a supplement is rather vague.

11 MR. HUNGAR: Your Honor, I think the
12 "sufficiently innovative" is more of a description
13 rather than a test; it's a description of what this
14 Court said in Graham. In Graham itself the Court laid
15 out the proper analysis which is you need to consider in
16 detail, not in the more cursory fashion that the Federal
17 Circuit's test encourages, but in detail the
18 capabilities of a person of ordinary skill and the
19 content of the prior art and the differences between the
20 prior art and the invention, and ascertain -- it's
21 ultimately a legal judgment informed by those detailed
22 factual inquiries, whether it is obvious or nonobvious
23 and entitled to patent protection.

24 And in addition I would point out that this
25 Court in Sakraida provided a framework for assessing

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1 patents like this one, where each of the elements is set
2 forth in the prior art and each of the elements in the
3 claimed invention is merely performing its already
4 known, previously known function as set forth in the
5 prior art.

6 JUSTICE SCALIA: Mr. Hungar, I have a
7 question that's sort of along the lines of Justice
8 Ginsburg's. It isn't just the Federal Circuit that has
9 been applying this test. It's also the Patent Office
10 and it's been following the Federal Circuit's test for
11 20 years or so.

12 What, what is -- assuming that we sweep that
13 test aside and say it's been incorrect, what happens to
14 the presumption of validity of, of patents which the
15 courts have been, have been traditionally applying?
16 Does it make any sense to presume that patents are valid
17 which have been issued under an erroneous test for the
18 last 20 years?

19 MR. HUNGAR: Your Honor, I think that it
20 would make sense because the statute requires it, and as
21 a practical matter it shouldn't make any difference,
22 because the only category of cases in which the result
23 would change under our test is the category in which as
24 a matter of law, in light of the factual issues that are
25 required under Graham, as a matter of law the Court

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1 concludes that the difference between the claimed
2 invention and the prior art is so trivial that it cannot
3 be given the protection of a patent. And in those
4 circumstances the presumption doesn't come into play.
5 It's a legal determination; the presumption has been
6 understood to effect the burden of proof, and in the
7 Federal Circuit's view the measure of the burden of
8 proof requiring clear and convincing evidence on the
9 underlying factual considerations, not the ultimate
10 legal determination.

11 But one of the problems with the Federal
12 Circuit's test is that it transforms what this Court
13 made clear in Graham is supposed to be a legal
14 determination. Ultimately it transforms it into a jury
15 question. Because in a case like this one where you
16 have as conclusory affidavits from respondent's experts
17 saying "oh, this would not have been obvious." And that
18 in the Court of Appeals view is enough to create a jury
19 question and then you then have to role the dice in
20 front of a jury in each one of these cases, except of
21 course the many cases in which the challenger can't meet
22 the teaching suggestion motivation test at all and
23 simply is unable to challenge the validity of the
24 patent, notwithstanding this Court's holding in Graham
25 that it's ultimately a legal determination -- admittedly

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1 one informed by detailed factual inquiries.

2 Another problem with the Federal Circuit's
3 test is that it devalues and de-emphasizes the statutory
4 focus and this Court's focus in Graham on the
5 capabilities of the person of ordinary skill.

6 CHIEF JUSTICE ROBERTS: Well when you talk
7 about the statutory focus, your innovation test -- I
8 mean, do you regard that, is that a legal conclusion of
9 nonobviousness? Or is it an additional test beyond what
10 the statute requires?

11 MR. HUNGAR: We haven't suggested an
12 innovation test, Your Honor. We were simply attempting
13 to describe in perhaps imprecise terms the holding of
14 this Court in Graham, and the holding of this Court in
15 Graham is that the ultimate inquiry for the court,
16 obviously suggestion, teaching, motivation, teaching a
17 way in the prior art, all of these are factual,
18 subsidiary factual issues that will shed light and a
19 great deal of light on the ultimate question in each
20 particular case, but ultimately the question for the
21 court is whether in light of all those underlying
22 factual showings the differences between the claimed
23 invention and the prior art are sufficient to, that they
24 would have been obvious to a person of ordinary skill in
25 the art. And that ultimately is a legal determination,

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1 you can refer to that as sufficiently innovative to
2 justify a patent, but the ultimate question, the
3 ultimate test is the one set forth in the statute and in
4 the Graham decision.

5 JUSTICE KENNEDY: In this case, would there
6 have been anything for a jury under your test?

7 MR. HUNGAR: No, Your Honor, because in this
8 case it is perfectly clear that it would have been
9 obvious for a person of ordinary skill to take the Asano
10 patent, add the sensor, the electronic sensor in a
11 manner that that off-the-shelf sensor is designed to be
12 added, and voila, you have a winning combination.

13 JUSTICE KENNEDY: What about claims 1, 2 and
14 3?

15 MR. HUNGAR: I don't know, Your Honor.
16 Those have not been litigated. Those have additional
17 limitations that are not present in claim 4 that,
18 depending on what the prior art might reveal about
19 those, we have no way of knowing whether they would or
20 would not be obvious because obviously, that question
21 has not been litigated. Certainly there is nothing in
22 the record in this case that would suggest they are
23 obvious.

24 JUSTICE GINSBURG: What about the experts?
25 You said this was obvious and this should have, not have

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1 gotten very far. But there were two experts, were there
2 not, who made declarations, that had all kinds of
3 credentials, and they called it elegant, novel and
4 nonobvious.

5 MR. HUNGAR: Yes, Your Honor. There are two
6 problems with that. Number one, the conclusory
7 assertion that an invention is nonobvious, just like the
8 assertion that it's obvious from an expert, should have
9 no weight because of course --

10 JUSTICE GINSBURG: Well these, these were
11 declarants who gave a whole declaration. They didn't
12 just say that bottom line.

13 MR. HUNGAR: But again, it's a legal
14 question. And moreover and more importantly, the
15 problem with the Court of Appeals analysis, one problem,
16 and with the experts' analysis, is that they're focusing
17 on the narrow definition of the quote unquote problem by
18 looking only at what this particular inventor was trying
19 to solve, but the scope of the claim is far broader.
20 Thank you.

21 CHIEF JUSTICE ROBERTS: Thank you,
22 Mr. Hungar. Mr. Goldstein.

23 ORAL ARGUMENT OF THOMAS C. GOLDSTEIN

24 ON BEHALF OF THE RESPONDENTS

25 MR. GOLDSTEIN: Thank you, Mr. Chief

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1 Justice, and may it please the Court:

2 I think the Court will want to have
3 available to it the red brief and also this big, which
4 is the supplemental joint appendix which has some of the
5 patents in it, and I'm going to quote from both of them.
6 I think you can't understand what motivation means and
7 what the whole test that the Federal Circuit is
8 employing means --

9 JUSTICE SCALIA: You're right about that.

10 MR. GOLDSTEIN: -- without --

11 (Laughter.)

12 MR. GOLDSTEIN: -- without starting from the
13 statute itself. And so I want to start with the
14 statutory text and use that as the jumping off point
15 like the Court of Appeals has for the inquiry that it's
16 asking. It's reproduced at page 21 of the red brief.
17 And Congress said it's the first blocked quote, that a
18 patent may not be obtained though the invention is not
19 identically disclosed or described, as set forth in
20 Section 102 of this title. Those are the other
21 requirements for giving a patent. If the differences
22 between the subject matter sought to be patented and the
23 prior art are such that the subject matter as a whole
24 would have been obvious at the time the invention was
25 made to a person having ordinary skill in the art. So

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1 the term of art here is obvious, and the plain meaning
2 of obvious, if you understand that the outcome of this
3 case is obvious or if you think that the, what the
4 Federal Circuit means by its test is not obvious, is
5 something that's either apparent or not apparent, and
6 that's what the Federal Circuit is asking. It says
7 look, take the invention and see whether or not it was
8 apparent or not apparent, and what the Federal -- to a
9 person of ordinary skill at the time of the invention.
10 And what the Federal Circuit says is, we want to be
11 inclusive.

12 The other side takes these words, teaching,
13 suggestion, motivation, as if they were words of
14 limitation rather than these words of inclusion. And
15 what the Federal Circuit has said is what we mean by
16 teaching a suggestion or a motivation, and it can be
17 explicit or implicit, is anything that would have made
18 this invention apparent to a practitioner at the time.
19 That's what it's after. It wants to know, look, was it
20 apparent to someone else, a practitioner at the time of
21 the invention of Engelgau to take Asano and put the
22 electronic throttle control on pin --

23 JUSTICE BREYER: Well, if that's all it
24 means, why don't they say it?

25 MR. GOLDSTEIN: They do say that.

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1 JUSTICE BREYER: Well, then what is this
2 word that confused me a lot, motivation? I found a lot
3 of enlightenment in Judge Rich's idea of taking all the
4 relevant art and putting it up around the room in
5 pictures. And then I thought, well, okay, if that art
6 teaches me to do what your client did, okay, it doesn't.
7 Does it suggest it? Not really. Well then, you say
8 motivated. Where does that get you?

9 MR. GOLDSTEIN: I understand. Can I take
10 you to their, the Federal Circuit's answer? It's two
11 pages before the quote that I just gave you, page 19,
12 there's another blocked quote. The Federal Circuit has
13 explained what it's talking about when it means a
14 motivation. They say that they have repeatedly held
15 that there is an implicit motivation to combine. It
16 exists not only when a suggestion may be gleaned from
17 the prior art as a whole, that's a teaching, but when
18 the improvement is technology independent and the
19 combination of references results in a product or
20 process. And these are common motivations. You would
21 do it because it's more desirable because it's stronger,
22 cheaper, faster, lighter, smaller, more durable, more
23 efficient.

24 JUSTICE BREYER: For who? For me?

25 MR. GOLDSTEIN: For a practitioner, yes.

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1 JUSTICE BREYER: For me the inventor?

2 MR. GOLDSTEIN: Yes.

3 JUSTICE BREYER: I know that, because

4 otherwise --

5 MR. GOLDSTEIN: No. Justice Breyer, you

6 don't understand.

7 JUSTICE BREYER: That's true.

8 (Laughter.)

9 MR. GOLDSTEIN: The question is not -- I can
10 illustrate it with this case. The question is not do
11 you want more efficient pedals. If that's the test,
12 then everything is obvious because we always want more
13 efficient pedals, Justice, and I'll come back to this.
14 It's always going to be the case that if your test is
15 capability, every patent including the first three
16 claims of this one is going to be obvious, because
17 you're always capable of assembling a pedal. What it
18 says, what the Federal Circuit says, is there a
19 motivation to make this invention? Was there
20 motivation, and this was the heart of the Federal
21 Circuit's ruling in this case, their theory is that
22 Asano renders our patent obvious. And the Federal
23 Circuit said all right, what's the motivation to take
24 Asano and take the electronic throttle control and make
25 it responsive --

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1 JUSTICE SCALIA: Well, the claim goes beyond
2 that. Your claim goes beyond the Asano combination and
3 in your brief you, you, you discuss the case as though
4 your, your limited claim 4 just relates to this
5 invention that you, you -- nobody would have thought of
6 using the Asano pedal in the Ford car given the limited
7 space available and so forth, and therefore, this was
8 really an invention. But that's not the claim. The
9 claim is simply combining the, any pedal, the Asano
10 pedal or any other one with the, with the automatic
11 electronic sensor.

12 MR. GOLDSTEIN: In a particular place, yes,
13 that's correct. Justice Scalia, the reason these
14 Federal Circuit judges were right notwithstanding your
15 correct point which is, just to be clear, our invention
16 is not limited to Asano. Our invention takes any fixed
17 pivot adjustable pedal and any electronic throttle
18 control and says combine it in a particular way. The
19 Federal Circuit's point is their motion rests on Asano.

20 The other side's theory is, we've got this
21 invention, Engelgau. As has been pointed out, nobody
22 did anything like this for 10 years. The other side
23 comes back and says yes, that it would have been obvious
24 to somebody who had an Asano to do the same thing
25 basically. And so the Federal Circuit said okay, show

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1 us. If this isn't going to be hindsight, where we just
2 give you the invention and you just say oh, I could have
3 done that, they say give us any evidence that someone
4 would have done what you say, which is take Asano, it's
5 their argument, Asano --

6 JUSTICE SCALIA: But why Asano?

7 MR. GOLDSTEIN: You'll have to ask them,
8 Justice Scalia. They filed a motion that it was
9 obvious.

10 JUSTICE SCALIA: You're the one that's
11 standing up here making that argument. They're not
12 doing it.

13 MR. GOLDSTEIN: Justice Scalia, the patent
14 examiner gave us a patent, initially rejected this
15 patent as obvious, decided that it wasn't after
16 considering all of these things, a statutory presumption
17 of validity attached under Section 282. So we have what
18 we say is clear and convincing evidence, the question
19 isn't presented here, but whatever. The other side
20 comes in and tries to knock our patent out. They file a
21 motion, and the motion rests on a piece of prior art.
22 And so what the Federal Circuit said is, if we're not
23 going to knock all of these patents out by hindsight,
24 all we want to know is one thing and you know, on
25 remand, they may well be able to prove it. We don't

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1 think they can. But all it's asking for is for the
2 district court to make a finding that says the other
3 side is right, that it would have been obvious to take
4 Asano, which is their only example, and combine it with
5 electronic throttle control in this way. That is what's
6 so --

7 JUSTICE BREYER: You look at that thing, you
8 think what this genius did, and I don't doubt that he's
9 a genius, is there are wheels that turn around. And the
10 wheels turn around to a fixed proportion to when you
11 make the accelerator go up and down. Now I think since
12 high school a person has known that if you have three
13 parts in a machine and they each move in a fixed ratio
14 one to the other, you can measure the speed of any part
15 by attaching a device to any other as long as you know
16 these elementary mathematics. I suppose it wasn't
17 Mr. Engelgau, it was probably Archimedes that figured
18 that one out. So he simply looks to something that
19 moves, and he sticks a sticker on it.

20 Now to me, I grant you I'm not an expert,
21 but it looks at about the same level as I have a sensor
22 on my garage door at the lower hinge for when the car is
23 coming in and out, and the raccoons are eating it. So I
24 think of the brainstorm of putting it on the upper
25 hinge, okay? Now I just think that how could I get a

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1 patent for that, and that -- now that's very naive,
2 that's very naive. But the point is, I don't see what
3 we're talking about, and what is supposed to happen with
4 all these affidavits. And the -- the -- Mr. Asano
5 himself, I would think at some point when the Ford
6 company decides to switch to electronic throttles, of
7 course will have every motivation in the world to do
8 precisely what your client did, because he can't use
9 that thing that pulls back and forth anymore. Rather,
10 he has to get a little electronic cap and attach it to
11 something that moves in fixed proportion to the
12 accelerator going up and down. Now those are my whole
13 reactions when I saw this and I began to think it looks
14 pretty obvious. What's supposed to go on, I don't
15 understand it.

16 MR. GOLDSTEIN: Okay. Let me answer it in a
17 few different ways because I want to again specify and
18 make clear what it is that the Federal Circuit says is
19 included within teaching, suggestions, motivations.
20 Then I want to turn to our invention and the affidavits
21 in the case. The Federal Circuit has said, and I'll
22 just -- you can come back to it for future reference.
23 It's recorded at the bottom of page 19 of our brief.
24 Common sense, common knowledge, common understandings
25 are all included within teaching, suggestions or

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1 motivations.

2 JUSTICE KENNEDY: It looks like Dystar was
3 decided by the Federal Circuit after it decided this
4 case, didn't it?

5 MR. GOLDSTEIN: Yes, it did.

6 JUSTICE KENNEDY: I mean, you have to be
7 defending what the Federal Circuit did in this case.
8 And the fact that they say well now, what this means is
9 really in some other case, that seems to me that's
10 really irrelevant.

11 MR. GOLDSTEIN: If I could just clarify,
12 Dystar --

13 JUSTICE KENNEDY: And I think you should
14 tell us when the case has been decided after, I think it
15 has much less, much less weight.

16 MR. GOLDSTEIN: Justice Kennedy, I agree
17 that you have to distinguish two things rightly. The
18 first is the state of the law as it exists now, and
19 that's what we ask you to affirm. And that is, the
20 Federal Circuit has made quite clear that its test is
21 inclusive, and we think that that establishes that it's
22 not necessary to add some new sort of undetermined test
23 of --

24 JUSTICE SCALIA: You say its test is
25 inclusive. I would say its test is meaningless. They

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1 have essentially said, our test simply reduces to what,
2 what your opponents in this litigation say. If you
3 think that's being inclusive, you know -- it doesn't add
4 anything whatever to -- to the -- to the question, would
5 a person of the ordinary skill in this field have
6 conceived of this idea.

7 MR. GOLDSTEIN: Justice Scalia, I disagree
8 for the following reasons, and that is: What the
9 Federal Circuit is saying is that any amount of
10 evidence, any form of evidence is relevant to answer a
11 particular question. We have a question that we want
12 answered. They have a question they want answered.
13 Their question, the petitioner at least, I'm not sure
14 about the Solicitor General, the petitioner's standard
15 is, was somebody capable of doing this? We have a
16 different question. Would it have been apparent to, and
17 that's what we think the text requires, would it have
18 been apparent to one skilled in the art? And so the
19 Federal Circuit is saying whatever evidence you want to
20 bring to bear --

21 JUSTICE STEVENS: Don't you think there's a
22 grammatical difference in the meaning of the word
23 obvious and the meaning of the word apparent?

24 MR. GOLDSTEIN: No, I don't.

25 JUSTICE STEVENS: So you're saying that the

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1 question is whether it's obvious?

2 MR. GOLDSTEIN: Yes, that's right. And what
3 the Federal Circuit is saying, you have -- what it's
4 saying is, if you just look to capability, and that is,
5 could you put Asano together on pin 54, you will miss
6 the most important part of invention. And that is,
7 invention isn't at the end when you put the two things
8 together. Invention is finding the problem, deciding
9 what pieces of the prior art to use, and deciding how to
10 put them together. Everybody is always capable of, it
11 will always be the case, I think, that a practitioner of
12 the art can put them together. Remember the very point
13 of a patent, when you look at our patent at the end of
14 the case, we were required to explain it in great
15 detail.

16 JUSTICE KENNEDY: Yes, but your -- the
17 Federal Circuit is saying that, the gist of it is if and
18 only if the previous patents taught this. But you, you
19 can look at these two devices, and you're a good
20 mechanic, you've never seen a patent, you've never read
21 these patents, you've never read these claims, you've
22 never been to the Supreme Court, and you put them
23 together.

24 MR. GOLDSTEIN: Justice Kennedy, that's
25 not --

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1 JUSTICE KENNEDY: And the Federal Circuit
2 said oh, it's not in the patent, it's not obvious.

3 MR. GOLDSTEIN: Justice Kennedy, with
4 respect, that is not a fair description of the Federal
5 Circuit's test, and I will take you to the language that
6 addressed this claim. It's at the bottom of page 18 of
7 our brief and also at the top of 19, and we quote the
8 Solicitor General's brief. The Solicitor General
9 asserts to the contrary, that Federal Circuit precedent
10 focuses attention exclusively on a search for teaching,
11 suggestions and motivations in the prior art. That is
12 not accurate. That was a quote from their brief.

13 Here is a quote from the Solicitor General.
14 It is from a new opinion of the Federal Circuit, but it
15 is quoting, it is citing a series of old opinions from
16 the Federal Circuit. Under our nonrigid motivation,
17 suggestion, teaching test, a suggestion to combine need
18 not be found in the prior art. And then there is the
19 blocked quote that I read to Justice Breyer about making
20 things cheaper, faster, lighter, common knowledge and
21 common sense.

22 JUSTICE ALITO: Well, once you define the
23 teaching, suggestion and motivation test that way so
24 that it can be implicit, it can be based on common
25 sense, I don't quite understand the difference between

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1 that and simply asking whether it's obvious. Could you
2 just explain what that adds?

3 MR. GOLDSTEIN: Well, all that it adds is an
4 analytical framework. It's an elaboration. The word
5 "obvious" --

6 CHIEF JUSTICE ROBERTS: It adds a layer of
7 Federal Circuit jargon that lawyers can then bandy back
8 and forth, but if it's -- particularly if it's
9 nonexclusive, you can say you can meet our teaching,
10 suggestion, or motivation test or you can show that it's
11 nonobvious, it seems to me that it's worse than
12 meaningless because it complicates the inquiry rather
13 than focusing on the statute.

14 MR. GOLDSTEIN: Mr. Chief Justice, the
15 reason that the Federal Circuit disagrees and over 30
16 years this special court has elaborated this problem --
17 these judges alone, for example, have heard 300 cases on
18 nonobviousness -- is that we need a guidance, we need
19 guidance for the lower courts. We need to focus them on
20 the right question, and for patent examiners and patent
21 practitioners, and the right question is not is -- was
22 someone merely capable of putting the two together. The
23 right question is is there any reason to believe that it
24 would have been apparent at the time of the invention to
25 create this invention whether it's through a teaching, a

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1 suggestion, a motivation.

2 JUSTICE SCALIA: Or anything else.

3 MR. GOLDSTEIN: Or anything else.

4 JUSTICE SCALIA: So why don't you say that?

5 MR. GOLDSTEIN: They have.

6 JUSTICE SCALIA: It is -- I agree with the
7 Chief Justice. It is misleading to say that the whole
8 world is embraced within these three nouns, teaching,
9 suggestion, or motivation, and then you define teaching,
10 suggestion, or motivation to mean anything that renders
11 it nonobvious. This is gobbledygook. It really is,
12 it's irrational.

13 MR. GOLDSTEIN: Justice Scalia, I think it
14 would be surprising for this experienced Court and all
15 of the patent bar -- remember, every single major patent
16 bar association in the country has filed on our side --

17 CHIEF JUSTICE ROBERTS: Well, which way does
18 that cut? That just indicates that this is profitable
19 for the patent bar.

20 (Laughter.)

21 MR. GOLDSTEIN: Mr. Chief Justice, it turns
22 out that actually is not accurate.

23 JUSTICE SCALIA: It produces more patents,
24 which is what the patent bar gets paid for, to acquire
25 patents, not to get patent applications denied but to

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1 get them granted. And the more you narrow the
2 obviousness standard to these three imponderable nouns,
3 the more likely it is that the patent will be granted.

4 MR. GOLDSTEIN: Justice Scalia, that is not
5 the point of these bar associations' either. These bar
6 associations, including the American Bar Association,
7 the American Intellectual Property Law Association, have
8 lawyers on both sides of all these cases. They're
9 looking for a test that has balance and that is what the
10 Federal Circuit has done. Now, let me just say --

11 JUSTICE BREYER: As you know, we've had a
12 series of cases and in these series of cases we have
13 received many, many briefs from all kinds of
14 organizations and there are many from various parts of
15 the patent bar that defend very much what the Federal
16 circuit does and there are many from parts of the patent
17 bar and others who are saying basically that they've
18 leaned too far in the direction of never seeing a patent
19 they didn't like and that has unfortunate implications
20 for the economy. So if you're going to these very basic
21 deep issues, is there a reason for me to think, which I
22 do now think, that there is a huge argument going on in
23 those who are interested in patent as to whether there
24 is too much protectionism and not enough attention paid
25 to competition or whether it's about right, or whether

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1 it goes some other way.

2 In other words, your argument now suggests
3 all this is well settled, but I tend to think maybe it
4 isn't well settled and maybe it is a proper thing for us
5 to be involved in. So what are your views since you
6 brought it up?

7 MR. GOLDSTEIN: Justice Breyer, there is a
8 big debate over whether or not there is too much
9 patenting in this country and Congress is involved in
10 the debate. What I don't think that there is that much
11 debate about is whether a properly applied test that the
12 Federal Circuit has articulated strikes the right
13 balance, because that is why all of the patent bar
14 associations have filed on our side, I think, and that
15 is it takes account of the interests of both sides and
16 that is it says, you're right, we have to be concerned
17 about overpatenting, it says on the other hand we have
18 to be very concerned about hindsight determinations of
19 obviousness.

20 But I do want to just step back and make a
21 point about judicial administration. If the ultimate
22 conclusion of this Court is that teaching, suggestion,
23 motivation just boils down into an inquiry into
24 obviousness, I still think that an opinion that says
25 that and says that it, that this Court believes that it

1 is embracing the bottom line of what the Federal Circuit
2 has been doing, is the one that will be much better for
3 the patent system and for the courts, because we have a
4 real concern and that was articulated -- asked about at
5 least by Justice Ginsburg and Justice Scalia, and that
6 is if you purport to change the rules unnecessarily, if
7 you say we're going off in a different direction, this
8 test has -- underlies 160,000 patents issued every year.
9 There is no rhyme or reason to applying a presumption of
10 validity if you're saying the patent examiner applied
11 the wrong test. And it will create genuine dramatic
12 instability.

13 The question I think is if you think instead
14 that the teaching, suggestion, motivation test is
15 incomplete, what is it that you want to add on top of
16 it, and that's really what I didn't understand from the
17 first half-hour. If it's going to be --

18 JUSTICE BREYER: It doesn't have to go on
19 top. It's just to say what you've been saying, that
20 what you're supposed to look to ultimately is whether a
21 person, as the statute says, who is familiar with the
22 subject, of ordinary skill in the art, whether to such a
23 person this would have been obvious. Now, there are
24 many, and this Court has listed several, factors that
25 might count in favor of it not being obvious, such as

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1 people have been trying to do it for a long time and
2 they haven't been able to figure out how. That's a good
3 one, and there are some other ones here. If there's a
4 teaching right there, it seems to cut the other way.

5 But to hope to have a nonexclusive list
6 seems to me a little bit like Holmes trying to hope to
7 have an exclusive list of what counts as negligence. In
8 the law we have many standards that you can get clues
9 about, but you can't absolutely define them, and why
10 isn't this one of them?

11 MR. GOLDSTEIN: Justice Breyer, I think
12 that's the dilemma that the Federal Circuit has been
13 facing and is in answer to the criticism of Justice
14 Scalia and that is the Federal Circuit isn't trying to
15 articulate every single possible thing that can show you
16 that it is obvious. What it's trying to do is focus you
17 on the right question. It's trying to say, here's the
18 process of invention: We have to figure out there's a
19 problem. We have to figure out what prior art you're
20 going to use. You have to figure out how you're going
21 to combine it, and then you actually combine it.

22 The act of invention, the thing that is the
23 discovery that we want to encourage, is there in the
24 middle. It's picking out the prior art and deciding how
25 to put it together.

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1 JUSTICE BREYER: Supposing we then were to
2 say exactly what this Court already said, that the
3 standard here is obvious, we list a few of these
4 additional factors that they've thrown in, and just as
5 the Court said before, all these additional factors are
6 there. They can be considered in an appropriate case,
7 but it is important to remember that the ultimate matter
8 which is for the judge is to apply the word "obvious" or
9 not in light of the evidence and what the experts say
10 and the facts as found by a jury or whoever is the
11 factfinder. Would you have any objection to an opinion
12 like that.

13 MR. GOLDSTEIN: No.

14 JUSTICE KENNEDY: Well then, in this case
15 let's assume that we all strike out on coming out with
16 the magic formulation. One of the ways the law
17 progresses is we go from case to case, and in this case
18 you have two standards of operation. One is a pedal
19 that basically operates by pressure. The other -- and
20 by levers. Other is by electronics, and these are two
21 different methods of making the carburetor release the
22 fuel. So why not, so somebody combines them. Why is
23 that such a big deal as, as claim 4 says it is.
24 Certainly this inventor would not be the only one to
25 think that the two could and should be combined.

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1 MR. GOLDSTEIN: Justice Kennedy, that's
2 absolutely right, and I just want to focus you on why it
3 is you now think I lose. We don't lose because that's
4 not our invention. The Federal Circuit's point was that
5 that this invention, claim 4, does not put an electronic
6 throttle control together with an adjustable pedal.
7 It's do it in a particular way. And let me take you in
8 summary judgment in this case to the declarations and
9 explain why it is that the experts here said you would
10 not have done this. And I just have to urge the Court
11 to cross the t's and dot the i's here and pay particular
12 attention to exactly what it is that we claimed and
13 exactly what it is that they said rendered our patent
14 obvious.

15 CHIEF JUSTICE ROBERTS: Where in claim 4 do
16 you say it's putting it together in a particular way?

17 MR. GOLDSTEIN: Mr. Chief Justice, if I can
18 take you to the big book that I asked you to --

19 CHIEF JUSTICE ROBERTS: Right, page 8.

20 MR. GOLDSTEIN: Page 8, exactly. And that
21 is, there are six different pieces to claim 4 and I'm
22 going to take you to the relevant one. And they are the
23 last two paragraphs here. We claim an electronic
24 control attached to the support, so we specify where the
25 electronic control is going to be. And then we say

1 where, what that electronic control is going to be
2 responsive to, and that's the next paragraph: Said
3 apparatus characterized by said electronic control being
4 responsive to said pivot, and that said pivot is defined
5 above to be a fixed pivot. So here is the design.

6 Let me take you to a picture if I could, and
7 that's going to be at the back of the red brief.
8 Engelgau is the third foldout page. It looks like this.
9 What we say is there is going to be a fixed pivot. It's
10 the red pivot in our picture, and there's going to be an
11 electronic throttle control. That's actually on the --
12 you can't see it because you're looking straight at the
13 device. That's on the next page. It's in green.
14 There's going to be an electronic throttle control and
15 it's going to respond to that pivot.

16 So we specify where we're going to put the
17 electronic throttle, on the support. That's what the
18 Federal Circuit recognized was our invention. Now --

19 JUSTICE BREYER: Is it basically an
20 invention where in fact there are only four or five
21 moving parts on the thing that we have seen, every one
22 of the moving parts is moving with a fixed ratio to the
23 accelerator going up and down, as it must be because
24 they're also moving in fixed ratio with the throttle
25 thing coming out. And so, whichever of those four that

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1 you figured out you were going to attach it to, it's
2 obvious, isn't it, that you have to attach it either to
3 the pedal or to the throttle thing that comes out, or to
4 a part of the machine that moves in fixed ratio to the
5 movements of one of those two? Now, that's what I would
6 find fairly obvious. Why isn't that obvious?

7 MR. GOLDSTEIN: All right. Let me, Justice
8 Breyer. The experts say it's not obvious and the reason
9 nobody did it for 12 years and the reason that Asano was
10 never combined with an electronic throttle control is
11 explained in the record in this case and it's twofold.
12 The first is, and I have to take you now to the picture
13 of Asano because that's what the claim that is supposed
14 to make our invention obvious is. They say you would
15 have done this with Asano. What the experts say is this
16 Asano thing, no one would ever use it at all.

17 CHIEF JUSTICE ROBERTS: Who do you get to be
18 an expert to tell you something's not obvious.

19 MR. GOLDSTEIN: You get --

20 CHIEF JUSTICE ROBERTS: I mean, the least
21 insightful person you can find?

22 (Laughter.)

23 MR. GOLDSTEIN: Mr. Chief Justice, we got a
24 Ph.D. and somebody who had worked in pedal design for 25
25 years.

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1 CHIEF JUSTICE ROBERTS: Exactly.

2 MR. GOLDSTEIN: And people who actually know
3 this industry. And they, there are two things that come
4 from the record in this case. The first is all of the
5 experts and Engelgau himself testified not simply, no,
6 this is not obvious, but you would have never used Asano
7 to solve this or any other problem with an electronic
8 throttle control.

9 JUSTICE SCALIA: Excuse me. You keep coming
10 back to Asano. Why do you keep coming back? Your claim
11 here does not say anything about Asano.

12 MR. GOLDSTEIN: Justice Scalia, the way
13 these cases are litigated, and properly so, is the other
14 side says this would be obvious in light of a particular
15 piece or collection of prior art. You may have a
16 nonprior art motivation to combine them, but you're
17 going to say something else already exists. They say
18 it's Asano, and you're going to combine it with
19 something else. This is their motion. Their argument,
20 the argument that was presented to the Federal Circuit,
21 was that you would take Asano. That's why --

22 JUSTICE SCALIA: I think they happened to
23 use Asano simply because that's what you stuck it on.
24 But I think their basis, their basic point, is anybody
25 would have thought to stick it on, whether it's stick it

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1 on Asano or stick it onto some other mechanical
2 accelerator mechanism.

3 MR. GOLDSTEIN: Well, that is not -- we did
4 not stick it on Asano. Nobody stuck it on Asano. They
5 picked Asano because it was the prior art of adjustable
6 pedal designs.

7 Justice Scalia, you --

8 CHIEF JUSTICE ROBERTS: Well, that's because
9 the Federal Circuit's approach focuses narrowly prior to
10 our grant of certiorari, allegedly more flexibly after,
11 on prior art, as opposed.

12 To I would say common sense. And so they
13 say we have to find something in prior art to show that
14 this was non -- that this was obvious.

15 MR. GOLDSTEIN: Mr. Chief Justice, that's
16 not correct. Even under a capability standard, even
17 under an extraordinary innovation standard, you are
18 going to compare something to prior art. You're going
19 to take what exists now and compare it to what existed
20 before, no matter what standard you're employing. And
21 what they did is they compared it to the prior art,
22 which is Asano, and the Federal Circuit said, all right,
23 you want to say it will come from Asano. It would not
24 come from Asano for either of two reasons.

25 The first is you would never use Asano.

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1 That's the expert testimony. The second is the reason
2 given by the PTO in its brief in this case and that is
3 you wouldn't put it on the pin that would render
4 Engelgau obvious. You would put it somewhere else.
5 They say that you would put it attached to a lever up
6 high. What I want to make clear is two things. The
7 first is, though the Federal Circuit has in recent
8 opinions been quite emphatic about how inclusive its
9 test is, it has consistently cited earlier Federal
10 Circuit precedent and said that the other side and the
11 people who claimed that their standard is too narrow and
12 misguided are mischaracterizing it. And the second is,
13 the judgment in this case quite explicitly acknowledges
14 and implies the implicit teaching, suggestion,
15 motivation standard.

16 So I don't want you to have the mistaken
17 impression that there has been some radical change in
18 Federal Circuit law. But no matter what one thinks
19 about the differential between Federal Circuit law today
20 and Federal Circuit law a year ago or two years ago,
21 there is a quite considerable cost by articulating a
22 desire to head off in a new direction, because there
23 will be dramatic instability in the patent system, the
24 incalculable investments that underlie current patents.
25 There is nothing fundamentally not functional about how

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1 the Federal Circuit is approaching this question. It
2 has had decades to look at this to try and elaborate a
3 standard. This court in cases like Sakraida and --

4 JUSTICE BREYER: And it so quickly modified
5 itself.

6 JUSTICE SCALIA: And in the last year or so,
7 after we granted cert in this case after these decades
8 of thinking about it, it suddenly decides to polish it
9 up.

10 MR. GOLDSTEIN: Justice Scalia, if you
11 actually believe that, then you just don't believe the
12 judges in the Federal Circuit because in each of these
13 opinions they say quite explicitly we are not changing
14 it.

15 JUSTICE ALITO: Would you dispute that in
16 some of the earlier cases, like Dembiczak with the
17 garbage bag that looks like a pumpkin, that this TSM
18 test was applied in a way that seemed to ask for
19 something quite explicit in the prior art?

20 MR. GOLDSTEIN: I do think that you can find
21 outliers. I think that's fair. These judges as I said
22 have heard 300 of these cases. There are mistakes in
23 the Patent Office; there are mistakes by judges. The
24 Federal Circuit explains in Dembiczak what it was
25 actually looking for is an explanation. It wasn't

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1 saying that you had to use the prior art, and it has
2 tried to make quite clear that the law is not that you
3 have to have prior art. Or that those decisions here
4 today.

5 You can't take, in a system that produces so
6 many patents, and say ah, look at this side swing
7 patent, or the garbage bags, and draw from that the
8 conclusion that the system is fundamentally broken.

9 Justice Breyer, I meant to come back to
10 that. We can look through the studies, we cite a series
11 of empirical studies in our brief that have looked at
12 this problem, the rhetorical claim that the obviousness
13 rule is leading to gross over-patenting.

14 JUSTICE STEVENS: Tell me again, just to be
15 sure I have it my -- tell me very briefly, what it is
16 that makes this invention nonobvious?

17 MR. GOLDSTEIN: Two things. The first is --
18 and they do arise from the other side's motion under
19 Asano. First you wouldn't have chosen Asano. The
20 second is the Federal Circuit explained -- excuse me,
21 the Solicitor General explains that you would have put
22 the electronic throttle control somewhere else,
23 technically on what's called pivot 60, which would not,
24 would have rendered, would have not have rendered
25 Engelgau obvious.

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1 JUSTICE STEVENS: The invention, to use an
2 old-fashioned term, is the decision of where to put the
3 control.

4 MR. GOLDSTEIN: That is the extent of the
5 entire invention.

6 CHIEF JUSTICE ROBERTS: And just -- what
7 makes it nonobvious is that it's attached to a nonmoving
8 piece?

9 MR. GOLDSTEIN: An adjustable pedal that has
10 a nonmoving pivot, yes.

11 JUSTICE SCALIA: But the claim doesn't
12 require that.

13 MR. GOLDSTEIN: Yes it does. It does. I
14 promise.

15 (Laughter.)

16 CHIEF JUSTICE ROBERTS: But just to follow
17 up from Justice Stevens' question, what makes this
18 nonobvious is the decision to place the electronic
19 control on a part of the car that doesn't move?

20 MR. GOLDSTEIN: On the support --

21 CHIEF JUSTICE ROBERTS: Right.

22 MR. GOLDSTEIN: And then a particular kind
23 of adjustable pedal. That's the state of the record so
24 far.

25 JUSTICE BREYER: I'm sorry. Doesn't the

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1 axis turn?

2 MR. GOLDSTEIN: Does the pivot turn?

3 JUSTICE BREYER: Isn't there an axis, and
4 the axis turns?

5 MR. GOLDSTEIN: Yes.

6 JUSTICE BREYER: The pivot rotates?

7 MR. GOLDSTEIN: The pivot rotates, but it
8 doesn't -- the difference is that the pivot doesn't move
9 with the adjustment of the pedal. It spins around, of
10 course, you have to have something that you can -- but
11 the prior art, almost all that involved a pivot that
12 when the pedal moved out, the electronic throttle
13 control would go with it.

14 CHIEF JUSTICE ROBERTS: And the wires would
15 get worn, worn down, right? And the invention here is
16 well, let's not put it somewhere where it doesn't move,
17 and so the wires won't move and it won't get worn down.

18 MR. GOLDSTEIN: That would be a motivation.
19 That's absolutely right, why you would want to improve
20 on the part. The Federal Circuit said that you would
21 never do it in the way that was described here. You may
22 be able to prove it some other way on a remand. This
23 was a very specific motion, and the Federal Circuit
24 faithfully addressed the claim of obviousness that was
25 presented to it.

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1 CHIEF JUSTICE ROBERTS: Thank you.

2 Mr. Dabney, you have three minutes remaining but you may
3 take four.

4 REBUTTAL ARGUMENT BY JAMES W. DABNEY

5 ON BEHALF OF PETITIONER

6 MR. DABNEY: Thank you, Mr. Chief Justice.

7 As someone who tries patent cases, there is
8 no legal regime that is a greater generator of patent
9 litigation than the teaching suggestion motivation test
10 that is urged by the respondent. Where in this
11 unbelievable situation where, in the District Court,
12 this Court's precedents were cited, were not followed.
13 In the Court of Appeals, this Court's precedents in
14 Anderson's-Black Rock and others were cited, not
15 distinguished, followed at all.

16 If the law of this Court had been applied in
17 the District Court I wouldn't be standing here right
18 now. The reason that we have this, this proceeding
19 going on is because of this extraordinary situation,
20 where notwithstanding that this Court has issued
21 precedents in a variety of circumstances dealing with
22 multiple technologies, lots of different kinds of
23 differences, lots of different kinds of alleged
24 innovation, they are simply not paid attention to in the
25 corpus of the Federal Circuit's case law up until about

1 a month ago.

2 So the, this Court could do no greater
3 service to the actual process of determining whether
4 claimed subject matter does and does not comply with the
5 statute than to decide with case. The worst possible
6 thing that can happen in this case is for the case not
7 to end here, and for the Court not to provide a
8 precedent as it has done in so many particular past
9 cases, and give the public an example of a particular
10 claim and a particular difference that does not meet the
11 standard.

12 What's made clear throughout the history of
13 patent decisionmaking is that no verbal formula is ever
14 going to get you there. What we have as a functional
15 approach; it's not as opposing counsel suggests -- is
16 "it" apparent, is "it" obvious, would it have been
17 obvious to do "it?"

18 What this Court has held over and over again
19 starting with the doorknob case in 1851 is to pose a
20 problem. Would it have --

21 JUSTICE KENNEDY: What about in this case
22 where the wires were getting frayed until this
23 disclosure?

24 MR. DABNEY: That's not, if you read the
25 affidavits carefully that is not an accurate

1 characterization of -- of any evidence put in by the
2 petitioner. That was an argument --

3 JUSTICE KENNEDY: So suppose I read the
4 record the other way. Suppose I read the record as
5 saying this invention stopped the wires from being
6 frayed and therefore it was an advance.

7 MR. DABNEY: That would be, to the extent
8 that that -- if that is established that could be taken
9 into consideration along with other facts.

10 JUSTICE BREYER: Why would that be? I mean,
11 I've worked out that the raccoons are gnawing the
12 machine, at the bottom of the garage door and that's a
13 problem. So I move it to the top of the garage door.
14 Does that suddenly -- nobody before thought of moving it
15 to the top of the garage door; nobody before had thought
16 of moving it to a different part that moves in a
17 constant ratio with the accelerator.

18 MR. DABNEY: What the statute calls for,
19 Justice Kennedy, is not to focus on a particular
20 subjective problem like fitting into a Ford F 350, or
21 particular difference between a prior art pedal that
22 provides wire chafing and a claimed invention. The law
23 has always required that the patentability be determined
24 by the smallest amount of difference. So if it were
25 true that there was wire chafing, that that was a

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1 problem that would have had to have been overcome, if
2 you started with a prior art pedal that, that provided
3 for wires to move -- well then, maybe that combination
4 would not make the claimed subject matter obvious.

5 But that would not foreclose the defendant
6 from saying well, this other technology over here that
7 doesn't suffer from that problem, it's a simple matter
8 to modify that, so the premise of the question, that
9 because there is some other potential combination that
10 might have been, might have been more difference or less
11 reason to modify it than the one that's relied on by the
12 petitioner, is legally not material to the decision in
13 this case.

14 So I respectfully submit that the -- I
15 really have to emphasize this. I mean, this is a
16 litigation between, you know, two real businesses. The
17 justified expectations, Justice Souter that I think this
18 Court has recognized over and over again, are the
19 expectations of real innovators, who make real products
20 and have real inventions. And -- and I think it would
21 come as a great surprise to the owner of the Asano
22 patent to find as Justice Breyer suggested, that in
23 order to supply it to a modern vehicle maker it would
24 have to pay tribute to the Engelgau patent.

25 Thank you.

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1 CHIEF JUSTICE ROBERTS: Thank you, Counsel.
2 The case is submitted.
3 (Whereupon, at 12:07 p.m., the case in the
4 above-entitled matter was submitted.)

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